

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

REMARKS

This Amendment is in response to the Office Action of December 3, 2004. Applicants respectfully submit that all the claims presently on file are in condition for allowance or appeal.

REJECTION UNDER 325 USC 101

Claims 14-20 were rejected under 35 U.S.C. 101 on the ground that the claimed invention is directed to non-statutory subject matter. Claims 14-20, as now amended, satisfy 35 U.S.C. 101.

REJECTION UNDER 325 USC 103

Claims 1-2, 7, 9, 11-15, 17-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cahill et al., hereinafter referred to as "Cahill" (U.S. Pat. 5,963,659), in view of Paltenghe et al., hereinafter referred to as "Paltenghe" (U.S. Patent application 2001/0011250 A1). Applicants respectfully traverse this rejection and submit that the claims on file are not obvious in view of cited references. In support of this position, Applicants submit the following arguments:

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

A. Legal Standards for Obviousness

The following are court opinions set the general standards in support of Applicant's position of non-obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), **"To establish a prima facie case of obviousness, three basic criteria must be met.** First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ... The initial burden is on the examiner to provide some **suggestion of the desirability** of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the **references must expressly or impliedly suggest the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."
- **In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is** not whether the differences themselves would have been obvious, but **whether the claimed invention as a whole would have been obvious.** The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- "With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a**

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

motivation to combine the references that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed.**" See *In re Rouffet*, 149, F.3d 1350 (Fed. Cir. 1998).

- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination.** *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

B. Summary of the Present Invention

Prior to discussing the merit of the obviousness rejection under 35 U.S.C. 103, it might be desirable to review a summary of the present invention and some of the features provided thereby.

In general, corporate entities typically collect, manage, and review massive amounts of information electronically on a daily basis. These processes are usually cumbersome and error-prone due to manual updates to related data and documents. The high error rates are caused by missing or wrong key information. In addition, there may be data inconsistencies.

These processes also tend to be user-unfriendly, hampering workflow and decision making due to their lack of integrating textual and numerical information. They further lack in efficiency, since duplicate information fields are entered and re-entered manually. Re-keying of certain data, presents another set of issues, namely reduced productivity and increased possibility of data entry errors. Furthermore, these processes are inflexible in handling data changes during the information gathering stage.

The present invention addresses these shortcomings and enables user-friendly, error-free data entry with minimal or no inconsistencies, thus increasing productivity and promoting a flexible method for the visualization of complete and coordinated information contained on a plurality of form pages. To this end, the system of the present invention uses

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

an electronic checklist that enables the automated population of data fields in the checklist, and the reuse of the collected data in other applications.

The system of the present invention reuses data entry in a plurality of integrated software applications directed to the management of information within an enterprise. In operation, a user initiates a request to image documents through a coversheet application. This coversheet application features an electronic checklist, which is used to validate critical data elements.

Based on the input, other data fields are populated automatically through links to other applications. The data collected in the coversheet will be used for automated indexing. The data collected can also be fed to other applications. The application is also the entry point for the submitter to check the status of the document submission and search for archived images.

C. Independent Claims 1, 14, and 20

Representative claim 1 was rejected based on the ground that Cahill teaches the steps of:

"processing an electronic cover to obtain a document image and to validate data elements related to the document ... Cahill does not explicitly disclose storing at least some of the data populated in the cover for reuse by the independent software applications. Paltenghe teaches: based on information contained in a cover, automatically collecting data and populating at least some data fields in the cover

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

by linking the at least some data fields to independent software applications (Paltenghe, page 4, paragraph 46, and figures 1 and figures 12; consumer enters data on "forms, applications, etc.". The data is stored in information bank ... It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Paltenghe's reuse information from applications into Cahill's applications to store and reuse information for other independent software application, since the combination would have provided user information for independent application process without repeatedly entering by the user."

Applicants respectfully traverse this rejection and submit the following arguments.

First Distinguishing Argument

Cahill generally relates to a method for retrieving images of documents. by placing a plurality of documents in a document imaging machine and forming an electronic image of each document, storing each electronic image in an electronic storage device, providing at least one user interface device in communication on a communication link with the electronic storage device, placing a request for at least one document image on the user interface device, transmitting the request by the communication link to the electronic storage device, searching the electronic storage device for the requested electronic image of the document, retrieving the at least one electronic image or providing an indication that the image was not found, storing the electronic image, if found, in an electronic file, for transmission to the user interface device at user option, providing the electronic image to the user interface device at

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

command of a user at the user interface device for storage at the user interface device and displaying the requested electronic image on a display of the user interface device.

Contrary to the present invention, Cahill describes how to get information OUT of an image system, and not IN the image system. The form used in Cahill is a search form to help retrieve documents, while the cover sheet application of the present invention serves the purpose of validating and gathering data from independent software applications, Cahill's passive form does not perform these functions.

Applicants are in agreement with the Examiner that Cahill does not explicitly disclose storing at least some of the data populated in the cover for reuse by the independent software applications. In essence, this statement confirms that Cahill does not disclose a very important feature of the present invention.

As described earlier, and as explained repeatedly in the present patent application, an important aspect of present invention is that the data is entered once in one application, and the present invention ensures that the data fields that have been entered are automatically available to, and inserted in integrated (or related) applications that require this data, without having to manually re-type the data.

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

In essence, the main reference, namely Cahill, does not capture the essence of the present invention, and thus **Cahill fails to consider the claimed invention as a whole.**

In order to make up for this missing element, the Examiner resorts to Paltenghe.

Second Distinguishing Argument

Paltenghe generally relates to a method for authenticating and authorizing data that is re-used to check whether a consumer possesses access right to a certain bank facility. While the present invention uses an electronic storage of document images, the claims are not limited to this feature. Rather, it is important to reiterate that the present invention describes the automatic reuse of already entered data (that was gathered manually or automatically from other applications).

While Paltenghe is based on one-time registration data which is stored and re-used every time a consumer logs-in again, the present invention is based on dynamic data, which is different for every user interaction and have to be manually inserted in the system by the user. One advantage of the present invention is that the user enters the data once in one application, rendering the data available for reuse in other applications. This feature is not disclosed in Paltenghe.

Similarly to Cahill, Paltenghe does not capture the essence of the present invention, and thus neither **Cahill, Paltenghe, nor the combination**

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

thereof, considers the claimed invention as a whole. As a result, the hypothetical combination of Cahill and Paltenghe, does not consider the invention as a whole, and thus, according to the legal authorities above, does not satisfy the prime facie case of obviousness.

Third Distinguishing Argument

Applicants submit that Cahill and Paltenghe cannot be properly combined in view of the legal grounds above. Neither Cahill nor Paltenghe provides evidence of a suggestion, teaching, or motivation to combine these two references. The legal authorities above require that the evidence be clear and particular, and note that broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."

More specifically, the fact that it would be desirable to combine "two" references, neither of which teaches the important elements of the invention as claimed, nor consider the invention as a whole, on the ground that such hypothetical combination would "store and reuse information for other independent software application, since the combination would have provided user information for independent application process without repeatedly entering by the user", does not qualify as "evidence" within the ambit of the legal authorities above.

Application Serial No.: 10/066,985
Amendment dated: February 2, 2002

Reply to Office action of: December 3, 2004
Attorney Docket No.: YOR920010745US1

Claim 1 is thus not obvious in view of Cahill or Paltenghe, and the allowance of this claim and the claims dependent thereon is earnestly solicited.

Independent claims 14 and 20 are allowable for containing a similar subject matter to that of claim 1. Therefore, claims 14 and 20 and the claims dependent thereon are also allowable.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Date: February 19, 2005

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Respectfully submitted,



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